UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/733,494 | 12/08/2000 | Michael C. Morrison | STL9-2000-0071US1/1855P | 2391 |

7590 08/12/2003

Joseph A. Sawyer, Jr.
Sawyer Law Group LLP
P.O. Box 51418
Palo Alto, CA 94303

| EXAMINER | |
|---|---|
| ABDI, KAMBIZ | |
| ART UNIT | PAPER NUMBER |
| 3621 | |

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 09/733,494 | MORRISON, MICHAEL S. |
| | Examiner | Art Unit |
| | Kambiz Abdi | 3621 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

1. The prior office action is incorporated herein by reference. In particular, the observations with respect to claim language, and response to presented arguments.

- Claims 1, 11, and 21 have been amended.
- Claims 1-30 are pending.

### *Response to Amendment*

2. The original rejection of the applicant's claims put forward by the examiner on the office action mailed on 14 January 2003 is maintained. The examiner has pointed out specific and selected parts of the prior art of record as directly related to the claim's language. The prior art of record clearly shows that a cookie with its associated information is maintained by the server and used to maintain a record of activities by the client as well as reestablishing the last activity in case of communication failure between server and client during the transaction. By this mean the server does not need to start the transaction from the start in case of communication failure, but to start the transaction from the point that the communication failure occurs, once the communication is reestablished, utilizing the cookie and its associated information maintained by the server is used to achieve this out come of reestablishment of transaction at the point of failure. There is no need of manual intervention from the client user as the system presented by the prior art of record has presented.

3. Applicant's arguments filed 22 May 2003 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 11-15, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,963,915 to Steven T. Kirsch or U.S Patent No. 6,311,269 to Gary L. Luckenbaugh et al.

As per claims 1, 11, and 21, Kirsch and Luckenbaugh clearly disclose,a method, system, and computer readable medium for conducting a transaction over a network, the network including a first system and a second system, the method, system, and program instructions comprising the steps of:
a) initiating a transaction session;
b) comparing a value of the first system with a value of the second system, wherein the value of the first system is associated with particular transaction session; and
c) continuing the transaction based on the comparison (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65,. To clarify both Kirsch and Luckenbaugh systems establish communication between a client and a server to retrieve certain information from a server, once this communication is established the server checks the client for existence of a cookie if such cookie exist the server compares the cookie with existing cookies in the storage at the server. Once the cookie has been verified depending on the last transaction the cooki has been related to the transaction will continue.)

As per claims 2, 12, and 22, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 1, 11, and 21, further;
Kirsch and Luckenbaugh clearly disclose,

- the first system comprises a client system and the second system comprises a server system (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

As per claims 3, 13, and 23, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 2, 12, and 22, further;

Kirsch and Luckenbaugh clearly disclose,

- the value of the client system is in a persistent client side data file (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

As per claims 4, 14, and 24, Kirsch and Luckenbaugh clearly disclose, all the limitations of claims 3, 13, and 23, further;

Kirsch and Luckenbaugh clearly disclose,

- the persistent client-side data file comprises a cookie (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

As per claims 5, 15, and 25, Kirsch clearly discloses all the limitations of claims 4, 14, and 24, further;

Kirsch and Luckenbaugh clearly disclose,

- b1) allowing the server system to compare the value in the cookie with the value in the server system (See Kirsch abstract, figure3 and associated text, column 3, lines 4-32, column 4, lines 48-64, and column 13, lines 15-51 and Luckenbaugh figures 2, 2B, 2C, 3, and 4 and associated text, column 3, lines 35-64, column 5, lines 14-64, column 7, lines 9-63, and column 8, lines 1-13 and lines 53-65).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-10, 16-20, and 16-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,963,915 to Steven T. Kirsch or U.S Patent No. 6,311,269 to Gary L. Luckenbaugh et al. as applied to claims above, and further in view of U.S. Patent No. 5,991,399 to Gary L. Grauke et al.

As per claims 6, 16, and 26, Kirsch and Luckenbaugh disclose all the limitations of claims 5, 15, and 25, further;

Grauke clearly teaches,

if the value in the cookie does not match the value in the server system, step c) further comprises:

- c1) generating an encryption key;
- c2) storing a portion of the encryption key in the cookie; and
- c3) storing the entire encryption key on the server system (See Grauke bstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process.

As per claims 7, 17, and 27, Kirsch and Luckenbaugh disclose all the limitations of claims 6, 16, and 26, further;

Grauke clearly teaches, that step c) further comprises:

- c4) allowing the server system to transfer encrypted information to the client system; and
- c5) allowing the server system to transfer a remaining portion of the encryption key to the client system whereby the encryption key is capable of being utilized by the client system to

decrypt the encrypted information (See Grauke abstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process based on an specific key for that particular data file payment.

As per claims 8, 18, and 28, Kirsch and Luckenbaugh disclose all the limitations of claims 7, 17, and 27, further;

Grauke clearly teaches,

- step c5) is performed in response to a payment transaction from the client system to the server system (See Grauke abstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process based on an specific key for that particular data file payment.

As per claims 9, 19, and 29, Kirsch and Luckenbaugh disclose all the limitations of claims 5, 15, and 25, further;

Grauke clearly teaches, if the value in the cookie does match the value in the server system, ABC discloses that step c) further comprises:

- c1) allowing the server system to transfer encrypted information to the client system; and
- c2) allowing the server system to transfer a remaining portion of the encryption key to the client system whereby the encryption key is capable of being utilized by the client system to decrypt the encrypted information (See Grauke abstract, figures 2, 4A and 4B and associated

text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process based on an specific key for that particular data file payment. .

As per claims 10, 20, and 30, Kirsch and Luckenbaugh disclose all the limitations of claims 9, 19, and 29, further;

Grauke clearly teaches,

- step c2) is performed in response to a payment transaction from the client system to the server system(See Grauke abstract, figures 2, 4A and 4B and associated text, column3, lines 5-20 and 60-68, column 6, lines 17-35, column 7, lines 8-68, and column 8, lines 1-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kirsch and Luckenbaugh and Grauke to achieve a greatly increased protection and control of downloads of data files by encrypting them and tracking the download process based on an specific key for that particular data file payment.

***Conclusion***

4. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

6. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**
**Washington D.C. 20231**

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Driv**
**7th floor receptionist, Arlington, VA, 22202**

**Abdi/K**
**August 9, 2003**

John W. Hayes
**JOHN W. HAYES**
**PRIMARY EXAMINER**